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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Spy Optic, Inc.

Serial No. 76/254,679

Kit M. Stetina of Stetina Brunda Garred & Brucker for Spy
Optic, Inc.

Henry S. Zak, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Cissel, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Spy Optic, Inc., seeks registration on the Principal
Register for the mark shown below:



for "wearing apparel, namely, T-shirts, shirts, shorts, pants, sweatshirts, sweatpants, hats, visors, shoes, sandals and belts," in International Class 25¹.

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's "SPY and design" mark, when used on its goods, so resembles the mark, FASHION SPY!, which is registered for "clothing, namely tops, skirts, shorts, skorts, pants, shirts, dresses, jumpers, jackets," as to be likely to cause confusion, or to cause mistake, or to deceive.²

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing.

We affirm the refusal to register.

Applicant argues that the two marks are different as to sight, sound and connotation, and that these collective dissimilarities weigh against a finding of likelihood of confusion. Applicant also argues that its items of wearing apparel are different from those listed by registrant, as its goods are associated with extreme sporting events. As such,

¹ Application Serial Number 76/254,679, filed on May 9, 2001, based upon an allegation of use in commerce since at least as early as December 1997.

² Registration No. 1,981,264 issued on the Principal Register on June 18, 1996, Section 8 affidavit has been accepted.

applicant contends that they move in different channels of trade. Furthermore, applicant argues that the allowance of registrant's FASHION SPY! mark for clothing over applicant's SPY mark for sunglasses shows that the United States Patent and Trademark Office has already made the determination that there is no likelihood of confusion between the word portions of the marks at issue herein.

By contrast, the Trademark Examining Attorney argues that confusion is likely when these respective marks, both having the arbitrary term "Spy" as their predominant element, are applied to the identified goods, which are in part identical.

In the course of rendering this decision, we have followed the guidance of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth the factors, which if relevant evidence is of record, must be considered in determining likelihood of confusion. In any likelihood of confusion analysis, two key factors are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We turn first to an examination of the goods. As noted by the Trademark Examining Attorney, some of the clothing items identified in the application and registration are identical (e.g., shirts, shorts and pants). Yet applicant has

enclosed copies of webpages demonstrating that its goods are associated with "extreme sporting events such as surfing, dirt bike riding, snow boarding, motor cross (sic), free skiing, skating and the like." (applicant's appeal brief, p. 19; response to Office Action dated February 20, 2002, Exhibits A - C). While these webpages clearly do reveal a focus on such sports, there is no such limitation in the identification of goods in the application. Hence, we must consider some of these listed goods to be legally identical, and the others to be closely related. Moreover, based upon the application and the cited registration, we must also presume that the goods of registrant and of applicant will move in the same channels of trade to the same classes of ordinary consumers.

Turning then to the marks, as our principal reviewing court, the Court of Appeals for the Federal Circuit, has pointed out, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

As applied to clothing, the word "fashion" must be deemed to be at least highly suggestive. On the other hand, the word "spy" is an arbitrary designation for these items of clothing.

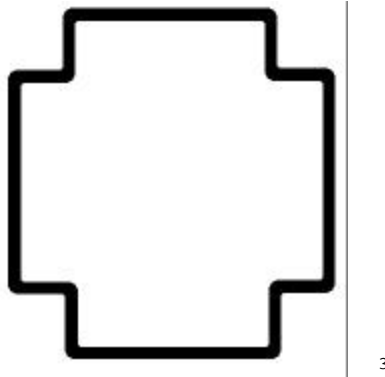
Accordingly, in spite of the extra word in registrant's mark, the single strongest source indicator therein is the word SPY.

As to the similarity in connotation, both marks create imagery tied to the generally understood, dictionary meaning of the word "spy." Hence, in spite of applicant's arguments to the contrary, both "Fashion Spy" and "Spy," as applied to items of clothing, connote clandestine activities, such as watching someone (or something) in secret.

The word "fashion" at the beginning of registrant's mark and the exclamation point at its ending are insufficient to distinguish the two marks when they are applied to identical and closely related goods. Similarly, the presence of applicant's shield design does create a somewhat different appearance, but we find that this too is insufficient to distinguish the two marks as to overall commercial impressions.

In finding that the marks are similar, we have kept in mind the fallibility of human memory over time and the fact that the average consumer retains a general, rather than a specific, impression of trademarks encountered in the marketplace. Further, we note that the record is devoid of any evidence of third-party uses of other "SPY" marks for goods similar to the types of goods involved in this case.

In support of applicant's position that the "shield" design is a prominent part of its mark, applicant has pointed to its earlier registration for sunglasses, for the mark shown below:



We accept that applicant considers this matter to be a separate source indicator for its sunglasses. However, when this device becomes a carrier for applicant's SPY mark (in the instant case, the interior area of the cross is darkened with the words presented as contrasting white letters against a black background), and is applied to items of clothing, the "shield" design *per se* becomes less important as a source indicator. Generally, the addition of a background device not easily described will not obviate confusion created by similar word marks. Rather, we agree with the Trademark Examining Attorney that the word SPY is the dominant portion of the mark and the portion that will be relied upon by consumers in

³ Reg. No. 2,157,268, issued on the Principal Register on May 12, 1998, claiming dates of first use of October 1996 on "sunglasses" in International Class 9.

calling for the goods in the marketplace, or in recommending the goods to others. As a general rule, design elements of a mark are of lesser import, because it is the word portion of a mark, rather than any design feature, unless highly distinctive, which is more likely to be remembered and relied upon by customers in calling for the goods. See Ceccato v. Manifattura Lane Gaetano Marzotto & Fugli S.p.A., 32 USPQ2d 1192 (TTAB 1994).

As to applicant's argument that the United States Patent and Trademark Office has already made the determination that there is no likelihood of confusion between the word portions of the marks at issue herein, we disagree with this conclusion. Given the cumulative differences in the respective goods (sunglasses versus clothing), when combined with the various differences applicant points out in the respective marks, it would have been extremely difficult for a Trademark Examining Attorney to have refused registrant's FASHION SPY! mark for clothing based solely upon applicant's SPY mark for sunglasses. Unfortunately (from applicant's perspective), registrant adopted its mark for clothing items in International Class 25 before applicant expanded to these "collateral" goods.

Decision: The refusal to register is affirmed.